

REMARKS

In the Office Action¹, the Examiner:

rejected claims 1-21 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 6-12 of co-pending U.S. Patent Application no. 10/720,920 (the '920 application);

rejected claims 1-21 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-37 and 110 of co-pending U.S. Patent Application no. 10/858,973 (the '973 application);

rejected claims 1-4 and 7-19 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,130,390 B2 to Abburi ("*Abburi*"); and

rejected claims 5,6, 20, and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Abburi* in view of U.S. Patent No. 6,628,194 B1 to Hellebust et al. ("*Hellbust*").

By the present amendment, Applicant has amended the specification and claims 1, 7, 12, 15, and 19. Claims 1-21 remain pending in this application.

I. Nonstatutory double patenting rejection² of Claims 1-21

In the Office Action the Examiner rejected claims 1-21 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 6-12 of the '920 application, and over claims 1-37 and 110 of the '973 application. Office Action, pages 2-3. Applicant respectfully traverses the nonstatutory obviousness-

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

² Applicant notes that the grounds of nonstatutory obviousness-type double patenting rejections of claims 1-21 are improper. This is because the M.P.E.P. only provides for grounds of **provisional** double patenting rejection in view of claims of co-pending applications. Thus, in order to advance prosecution Applicant assumes that the nonstatutory double patenting rejection was a provisional nonstatutory obviousness-type double patenting rejection, and requests clarification if this assumption is not correct.

type double patenting rejections of claim 1-21, and requests that the Examiner hold the rejections in abeyance. Both, the '920 application and the '973 application are currently pending and, thus, no double patenting circumstances can arise until a patent is granted. Therefore, Applicant respectfully requests that the provisional rejection be held in abeyance and any resolution in the form of a Terminal Disclaimer or otherwise be deferred.

II. Rejection of Claims 1-4 and 7-19 under 35 U.S.C. § 102(e)

Applicant respectfully traverses the rejection of claims 1-4 and 7-19 under 35 U.S.C. § 102(e) as being anticipated by *Abburi*. In order to properly establish that *Abburi* anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 recites a method for providing a notification to a telephone user including, for example, "generating a notification by **identifying, from the plurality of data types, a data type of the incoming data**" (emphasis added). *Abburi* does not teach, or even suggest, at least these elements of Applicant's claimed invention.

Abburi discloses:

designing improvements in messaging by which individuals can send and receive voice and other audio messages, in **audio form**, using telephone devices located on a telecommunications network and/or computer devices located on a widely distributed computer network. Upon receiving an audio message on behalf of an intended

recipient, the system accesses a user profile to determine how the intended recipient should be contacted. . . . The audio message is then delivered to the intended recipient in **audio form** through either a computer device located on the widely distributed computer network or a telephone device located on the telecommunications network. In this manner, a person may send a voice or other audio message to an intended recipient using either a computer device or a telephone device. (Emphasis added, column 1, line 64-column 2, line 10).

Thus, in *Abburi* an "Audio Messaging System and Method" is provided, where only one type of data is being received and then delivered to an intended recipient. Such a disclosure does not constitute the claimed "identifying, **from the plurality of data types**, a data type of the incoming data" (emphasis added) as recited in claim 1. This is because *Abburi* delivers data only in audio form and does not identify a data type of the incoming data "from the plurality of data types." In fact, there is no need to identify a data type in *Abburi* because the disclosure of *Abburi* is limited to only delivering data in audio form.

Therefore, *Abburi* does not teach, or even suggest, the claimed features including, for example, "generating a notification by **identifying, from the plurality of types of data, a data type of the incoming data**" (emphasis added) as recited in claim 1. Accordingly, *Abburi* cannot anticipate claim 1. Thus, claim 1 is allowable for at least these reasons.

Independent claims 12, 15, and 19, while of different scope, recite features similar to those of claim 1 and are thus allowable over *Abburi* for reasons similar to those discussed above in regard to claim 1. Claims 2-4, 7-11, 13, 14, and 16-18 are also allowable at least due to their dependence from one of the independent claims.

III. Rejection of Claims 5, 6, 20, and 21 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the Examiner's rejection of claims 5, 6, 20, and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Abburi* in view of *Hellebust*. A *prima facie* case of obviousness has not been established with respect to these claims.

Claims 5, 6, 20, and 21 depend from claims 1 and 19, respectively, and thus include all features of their base claims. As discussed above, *Abburi* does not teach, suggest, or render obvious each and every feature of independent claims 1 and 19, which are included in claims 5, 6, 20, and 21. Moreover, *Hellebust* fails to cure the deficiencies of *Abburi* discussed above. *Hellebust* does not teach or suggest the claimed features, including for example, "generating a notification by **identifying, from the plurality of data types, a data type of the incoming data**" (emphasis added) as recited in claim 1, and similar recitations in claim 19.

For this reason the Office Action has failed to clearly articulate a reason why *Abburi* and *Hellebust* would render the claimed combination obvious to one of ordinary skill in the art. Thus no *prima facie* case of obviousness has been established with respect to claims 5, 6, 20, and 21.

Accordingly, Applicant requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 5, 6, 20, and 21.

CONCLUSION


In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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